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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,001	08/01/2003	Walter Harvey Waddell	2003B079	8961

23455 7590 07/31/2007
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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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07/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/633,001

Applicant(s)

WADDELL ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-25, 27-35, 38-43 and 46-83.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.

10/633,001

Examiner

Vickey Ronesi

Applicant(s)

WADDELL ET AL.

Art Unit

1714

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The amendment document filed on 17 July 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: See Continuation Sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

Continuation of 4(e) Other: Claim 11 has a status identifier of "previously amended" but should be "currently amended".

Attachment to Advisory Action

On page 14 of the amendment, applicant traverses the finality of the first action following submission of the RCE as premature. In response, it is the examiner's position that the amendment filed with the RCE was identical to the after-final amendment filed on 12/1/2006 which was entered by the examiner in the Advisory mailed on 12/18/2006.

Applicants' amendment filed 7/17/2007 has been fully considered; however, the amendment has not been entered given that it is not in compliance.

With respect to non-compliance issues, see the attached "Notice of Non-Compliant Amendment." Although not in compliance, in the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given.

Applicant's response filed on 7/17/2007 has been fully considered but is not persuasive. Specifically, applicant argues (A) that unexpected results are established with applicant's statistical model and (B) that applicant's data is reasonably commensurate in scope with the scope of the claims.

With respect to argument (A), first, applicant states on page 15 that the showing of improved results is not unexpected given that a model is used to predict combination of properties. Therefore, it is not made clear how this data can be unexpected if one of ordinary skill in the art can use this model and obtain the presently claimed invention and its advantageous combination of properties. Second, the fact that the comparative data does not include polybutene oil is another concern because Dias already teaches polybutene oil as the

Art Unit: 1714

required processing oil. Applicant has not made a comparison to the closest prior art. Case law holds that comparative showings must compare the claimed subject matter with the closest prior art to be effective. See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979). In particular, Dias et al already teaches the desirable use of polybutene oil. Without a showing that non-inventive carbon blacks would be different when combined with polybutene oil in amounts greater than 80 phr, no criticality can be established for the presently claimed invention.

With respect to argument (B), the examiner has considered the 3 types of carbon black used in the inventive data in the specification as originally filed and maintains that these carbon blacks are not commensurate in scope with the claimed carbon black which has $\text{DBP} < 80 \text{ cm}^3/100 \text{ g}$. In particular, Regal 90 ($\text{DBP} = 33 \text{ cm}^3/100 \text{ g}$), Regal 90 ($\text{DBP} = 32 \text{ cm}^3/100 \text{ g}$), and N-990 ($\text{DBP} = 42 \text{ cm}^3/100\text{g}$) are exemplified, wherein DBP of 32, 33, and $42 \text{ cm}^3/100 \text{ g}$ cannot be used to establish criticality for less than $80 \text{ cm}^3/100 \text{ g}$ when compared to N660 ($\text{DBP} 90 \text{ cm}^3/100 \text{ g}$). The contention that "the exact limit [of DBP] is somewhere between 42 and 90" (page 17) does not alter the examiner's position.

Additionally, the exemplified amounts of carbon black are only as high as 120 phr. Given that the amount of carbon black significantly affects the properties as shown by Tables 5 and 6, applicant cannot establish a statistically commensurate scope of up to 200 phr carbon black (note that this amount of carbon black is not the total amount of all carbon black, rather, it is the amount of carbon black having surface area $< 30 \text{ m}^2/\text{g}$ and $\text{DBP} < 80 \text{ cm}^3/100\text{g}$).

Finally, only bromobutyl elastomers are exemplified and cannot establish criticality for presently claimed generic elastomer comprising at least 30 mol % isobutylene.

Art Unit: 1714

Case law holds that evidence of superior properties in one species is insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

7/24/2007

Vickey Ronesi

VR

/Vasu Jagannathan/
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